



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,543	01/27/2005	Toshiki Mori	2185-0746PUS1	8545

2292 7590 07/31/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

1712

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/31/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/522,543	Applicant(s) MORI ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>27 January 2005</u> . | 6) <input type="checkbox"/> Other: ____ |

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending application no. 10/525,067 as represented by Fujiki et al. Publication No. 2005/0247402 in view of Kawate et al. Patent No. 6,051,652 and Japanese Patent No. 9-12797 (Japanese '797).

This is a provisional obviousness-type double patenting rejection.

1. The claims of the copending application denote an adhesive film for a laminate prepared from an epoxy group-containing ethylene copolymer, a copolymer of ethylene and/or propylene and an anhydride, and an antioxidant (claim 6). The claimed component (A) of an amino acid or imidazole is not recited.

Art Unit: 1712

2. Kawate et al. (col. 10, Table 1, Example 10) shows an adhesive film for a laminate (col. 8, lines 42-49) comprising 60 parts by weight of (A) an ethylene-glycidyl methacrylate copolymer (col. 11, lines 2-5) containing from 40-99% by weight of ethylene and from 1-60% by weight of glycidyl methacrylate (col. 4, lines 8-10), and 5 parts by weight of (F) of 2,4-diamino-6-[2'-methyl-imidazolyl-(1')]ethyl-s-triazine and optional components (col. 6, lines 65-67).
3. Japanese '797 discloses a sheet for a laminate (translation, page 3, lines 1 and 2 and paragraph 16, Example 1, line 4) obtained from a copolymer of 66 mol% of ethylene, 33 mol% of methyl acrylate and 1 mol% of glycidyl methacrylate (page 5, paragraph 24, Copolymer A), an imidazole compound (col. 2, paragraph 13) and an antioxidant (page 2, paragraph 14).
4. It would have been obvious to obvious to employ the imidazole compounds of Kawate et al. and Japanese '797 in order to increase the crosslinking density (Kawate et al., col. 6, lines 23-25 and 30).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawate et al. for the reasons espoused in paragraph 2 hereinabove.

Art Unit: 1712

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawate et al. as applied to the claims hereinabove, and further in view of Japanese '797.

6. Kawate et al. does not recite the copolymer further polymerized from an non-epoxy reactive monomer along with the presence of an antioxidant. Japanese '797 is explained in previous paragraph 3.

7. It would have been obvious to copolymerize the ethylene-glycidyl methacrylate copolymer of Kawate et al. with the (meth)acrylic ester monomer of Japanese '797 in order to optimize the crystallinity, elasticity and oil-proof characteristic (Japanese '797, page 2, lines 1-2). It would have been obvious to incorporate the antioxidant of Japanese '797 as an optional component in Kawate et al. in order to prevent deterioration by oxygen.

Claims 1-3, 5, 6-8 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohme et al. Publication No. 2004/024803.

8. Ohme et al. (pages 22-23, Table 12, Example 14-8) shows a film for a laminate (page 14, paragraph 179 and Figure 1) produced from 3 parts by weight of montmorillonite treated with 12-aminodecanoic acid H-1 and 14 parts by weight of an ethylene/glycidyl methacrylate copolymer.

Claims 1-7 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 63-112617 (Japanese '617).

9. Japanese '617 (abstracts) reports a formulation containing from 50-85 mol% of ethylene, from 15-50 mol% of a (meth)acrylate and from 1.0-8 mol% of an unsaturated glycidyl ester, an imidazole such as a 2-phenylimidazole/triazine complex (Derwent abstract), and an antioxidant (HCAPLUS abstract).

Claims 1-7 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Nos. 9-12797 (Japanese '797) and 2003-137969 (Japanese '969).

Japanese '797 is discussed in paragraph 3 hereinabove.

10. Japanese '969 is directed to an adhesive film for a laminate (translation, page 8, paragraph 51, line 8) derived from an ethylene-glycidyl methacrylate copolymer (HCAPLUS abstract), a polymerization initiator such as an imidazole

Art Unit: 1712

(page 3, paragraph 14, line 4) and an antioxidant page 5, lines 1-7).

11. Although the imidazoles of the Japanese patents are not exemplified, it would have been obvious to use the disclosed imidazoles in order to enhance the cure rate.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese '617, '797 and '969 as applied to the claims hereinabove, and further in view of Kawate et al.

12. The claimed species of imidazole are not recited. Kawate et al. is described in previous paragraph 2. It would have been obvious to utilize a particular species of imidazole such as the 2,4-diamino-6-[2'-methyl-imidazolyl-(1')]ethyl-s-triazine of Kawate et al. in order to optimize the curability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers
Primary Examiner
Art Unit 1712

rs 7/25/2007